UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,746	10/27/2003	Itaru Furukawa	50063-069	8831

7590 04/02/2009

McDERMOTT, WILL & EMERY
600 13th Street, N.W.
Washington, DC 20005-3096

EXAMINER	
YUAN, KATHLEEN S	

ART UNIT	PAPER NUMBER
2624	

MAIL DATE	DELIVERY MODE
04/02/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/692,746	FURUKAWA ET AL.	
	Examiner	Art Unit	
	KATHLEEN S. YUAN	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 February 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-36* is/are pending in the application.

4a) Of the above claim(s) *1-11,16-29 and 34-36* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *12-15,30-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

The response received on 2/13/2009 has been placed in the file and was considered by the examiner. An action on the merit follows.

Response to Amendment

1. The amendments filed on 13 February 2009 have been fully considered. Response to these amendments is provided below.

Summary of Amendment/ Arguments and Examiner's Response:

2. The applicant has amended the claims to exclude correction after proofreading as a prepress processing step for the second RIP data. The applicant also amended the claim in attempts to overcome previous 101 rejections and 112 rejections.

3. The amended limitations are addressed below. The 112 rejections are overcome, but the 101 rejection is not overcome. For more explanation, please see the rejection below.

4. *The applicant argues on page 17 of the remarks that "Katsuya fails to disclose the limitations of claims 12 and 20 regarding '(a second RIP processor for)…excluding after proofreading." Further arguing that the second raster type data of Katsuya is obtained by performing raster conversion not on the original page description data, but by performing raster conversion on the first raster type data, which has been subject to the raster conversion already, and that the claimed subject matter is prepared by executing RIP processing on a second print image data; the second print image data is obtained by carrying out another prepress processing to the first print image data.*

5. By the way the applicant claims the subject matter, Katsuya et al does teach all the claimed limitations, excluding the limitation regarding the exclusion of correction after proofreading. To further explain, Katsuya discloses the raster conversion on the original page description data into raster type data from the raster conversion of the page description data, as disclosed in the first few lines of the solution of the abstract. Furthermore, the claimed subject matter (besides "excluding correction after proofreading") is disclosed: the second RIP data/ latest page description data is converted into raster type data; the second print image data is obtained by carrying out prepress processing to the first print image data: a correction of the data (paragraph 9 of the Japanese translation). The argument of “excluding correction" is moot in view of new grounds of rejection.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 12-15 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent[1] and recent Federal Circuit decisions[2] indicate that a statutory “process” under 35 U.S.C. 101 must (1) be tied to an apparatus or a machine or (2) transform underlying subject matter (such as an

---

[1] *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

[2] *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

article or material) to a different state or thing. While the instant claim(s) recite a series of steps or acts to be performed, the claim(s) neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. Furthermore, the tie must be meaningful. A machine tied only to an intended use statement or to insignificant pre or post solution activity is not a meaningful tie. The tie must be in relation to a step or steps that are significant to the invention, or basic inventive concept. For example, although the applicant has claimed that the method is processed in a printing prepress system, the limitation was added to the preamble which is not given patentable weight. The preamble to the claim is not given any patentable weight because it doesn't breathe life or vitality into the claim. The applicant must tie a particular machine to the body of the claim, in a step/ part of the claim the applicant considers their invention/ inventive step.

Claim Objections

8. The follow quotations of 37 CFR § 1.75(a) and (d)(1) provide the basis of objection:

> (a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.
>
> (d)(1) The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. (See § 1.58(a)).

9. Claims 12-15 and 30-33 are objected to under 37 CFR § 1.75(a) and (d)(1) as failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention or discovery, and failing to conform to the invention as set forth in the remainder of the specification.

10. The applicant has claimed that the prepress processing step carried out on the first data to get the second data excludes “correction after proofreading." Dictionary.com defines "proofread" as ”to read (printers' proofs, copy, etc.) in order to detect and mark errors to be corrected. “ Therefore, the applicant has excluded the process as being a correction after detection of errors to be corrected. The specification and applicant’s remarks on page 16, provides the prepress processing step as "preflight" processing, and the specification further defines preflight processing as “Preflight processing, or so-called pre-processing, is processing for analyzing the contents of original print image data, and checking whether or not the processing for prepress can be executed without a problem.” (paragraph 57 of the PGPub). Therefore, the invention according to the specification defines preflight processing as finding problems/ errors in the original print image data and obtaining a correction result after the errors are found. This directly conflicts with the claim.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. Claims 12-15 and 30-33 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The examiner cannot find support in the specification that states that the prepress processing step to get the second data is excludes correction after proofreading. In fact, paragraph 57 of the PGPub supports correction after proofreading, as explained above.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. Claims 12 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Abstract and machine translation of Publication No. 10-154234 (Katsuya et al) in view of U.S. Patent No. 5473748 (Date et al) or U.S. Patent No. 5418894 (Kitamura et al).

15. Regarding claim 30, Katsuya et al discloses a prepress system (title) comprising: a first RIP processor for preparing a first RIP data, that which processes the page description data that is saved as the first proofreading (abstract), by executing RIP

processing, obtaining raster conversion (abstract), on a first print image data according to first RIP processing condition of bring the initial image data (abstract),a second RIP processor for preparing a second RIP data, that which processes the second proofreading (abstract) by executing RIP processing, in accordance with second RIP processing conditions that differ from the first RIP processing conditions, the conditions being that the image is corrected in result of proofreading, on a second print image data obtained by carrying out another prepress processing, the processing occurring before printing, and is therefore prepress processing (paragraph 2) to the first print image data, the prepress processing being the correction to obtain the latest page description data (abstract); a converter for preparing a first plate image-inspection RIP data, that which converts the data in a value of density by pixel (abstract), in accordance with standard RIP processing conditions by converting the first RIP data using a first profile representing relationship between the standard RIP processing conditions and the first RIP processing conditions by converting the data into density by the pixel, therefore comparing the standard RIP known conditions of if a pixel is a certain way, then it is converted to a certain density to the first RIP processing conditions of being the initial data and using the initial data as what is converted (abstract), and for preparing a second plate image-inspection RIP data, the second proofreading that is converted by density (abstract) in accordance with the standard RIP processing conditions by converting the second RIP data, using a second profile representing relationship between the standard RIP processing conditions and the second RIP processing conditions, as explained above for the first RIP processing conditions, except the

second RIP processing conditions are used in the second plate image-inspection data; and a comparator for comparing the first and second plate-image-inspection RIP data to detect differences between the first and second print image data, that which performs the comparison by the pixel (abstract). Furthermore, the comparison is made in order to find the part that is changed by the proofreading.

Katsuya et al does not disclose expressly that the another prepress processing step excludes correction after proofreading.

Date et al or Kitamura et al discloses another process in which second print image data is obtained by carrying out the process of adding ornamental effects (date et al, col. 1, lines 24-26) or changing the tint (Kitamura et al, col. 1, lines 20-25), which is not necessarily a correction after proofreading; it is a preference change by the user.

Katsuya et al and Date et al or Kitamura et al are combinable because they are from the same field of endeavor, i.e. prepress processing.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use a prepress process that excludes correction after proofreading.

The suggestion/motivation for doing so would have been to provide a more flexible system by allowing the system to check for all changes that is made to the data, including elective changes by a user.

Furthermore, KSR vs. Teleflex Co dictates that simple substitution of one known element for another to obtain predictable results is obvious. Katsuya et al disclosed a known method/ device that differs from the claimed device only in that the process excludes correction after proofreading. The substituted component: an elective process

that changes the print image data such as the tint or ornamental effects were known in the art, as shown by Date et al and Kitamura et al. One of ordinary skill in the art count have substituted the correction after proofreading process with the elective process, and the results would have been predictable, a result of finding the part that is changed from the process of changing color, or ornamental effects.

Therefore, it would have been obvious to combine the system of finding changes in RIP data of Katsuya et al with the prepress processing of Date et al or Kitamura et al to obtain the invention as specified in claim 30.

16. Claim 12 is rejected for the same reasons as claim 30. Thus, the arguments analogous to that presented above for claim 30 are equally applicable to claim 12. Claim 12 distinguishes from claim 30 only in that claim 30 is a system and claim 12 is a method. Since a system carries out a method, prior art applies.

17. Claims 12-13 and 30-31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Katsuya et al in view of Date et al or Kitamura et al, as applied to claims 12 and 30 above, in view of U.S. Patent Application Publication No. 20030026457 (Nahum). Claims 12 and 30 are reinterpreted below.

Regarding claim 30, Katsuya et al discloses all of the claimed elements as set forth above and incorporated herein by reference. Katsuya et al further discloses another way of interpreting the processing conditions, as with resolution. Katsuya et al's first processing condition would be the resolution in which the first RIP data is obtained, and the second processing condition would be the resolution in which the second RIP

data is obtained, which can differ (paragraph 43). Katsuya et al further discloses that the resolutions can be converted to match to the image with the lowest resolution (paragraph 43). Therefore, the first and second plate-image-inspection RIP data can be interpreted as the converted image with matching resolution.

Katsuya et al does not disclose expressly that the another prepress processing step excludes correction after proofreading.

Date et al or Kitamura et al discloses another process in which second print image data is obtained by carrying out the process of adding ornamental effects (date et al, col. 1, lines 24-26) or changing the tint (Kitamura et al, col. 1, lines 20-25), which is not necessarily a correction after proofreading; it is a preference change by the user.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use a prepress process that excludes correction after proofreading.

The suggestion/motivation for doing so would have been to provide a more flexible system by allowing the system to check for all changes that is made to the data, including elective changes by a user.

Furthermore, KSR vs. Teleflex Co dictates that simple substitution of one known element for another to obtain predictable results is obvious. Katsuya et al disclosed a known method/ device that differs from the claimed device only in that the process excludes correction after proofreading. The substituted component: an elective process that changes the print image data such as the tint or ornamental effects were known in the art, as shown by Date et al and Kitamura et al. One of ordinary skill in the art count have substituted the correction after proofreading process with the elective process, and

the results would have been predictable, a result of finding the part that is changed from the process of changing color, or ornamental effects.

Interpreting "processing conditions" as resolution (as in claim 31) Katsuya et al (as modified by Date et al or Kitamura et al) does not disclose expressly both first and second plate-image-inspection RIP data are converted into a standard resolution, therefore, using a first/second profile representing relationship between the standard RIP processing conditions and the first/second RIP processing condition since in order to convert the first/ second data to a standard resolution, a relationship would be found to find how the first/second resolutions compare to the standard resolution.

Nahum discloses before comparing images of different resolution, converting both the images to a standard resolution, lower resolution (page 1, paragraph 9).

Katsuya et al (as modified by Date et al or Kitamura et al) and Nahum are combinable because they are from the same field of endeavor, i.e. comparison of images.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to reduce the resolution in both images to a standard, lower resolution.

The suggestion/motivation for doing so would have been to provide a faster system by lowering the computational load.

Therefore, it would have been obvious to combine the image matching system of Katsuya et al (as modified by Date et al or Kitamura et al) with the lowering of resolution in comparison images of Nahum to obtain the invention as specified in claim 30.

18. Regarding claim 31, Nahum discloses the standard RIP processing conditions include, as a parameter, a resolution lower than a resolution in the initial images to be compared (page 1, paragraph 9). Katsuya et al a final outputting step of outputting raster data of a high resolution, indicating a resolution of the initial images (paragraph 43). Therefore, the combination of Nahum and Katsuya et al discloses that the standard resolution is lower than the final output.

19. Claims 12 and 13 are rejected for the same reasons as claims 30 and 31, respectively. Thus, the arguments analogous to that presented above for claims 30 and 31 are equally applicable to claims 12 and 13. Claims 12 and 13 distinguish from claims 30 and 31 only in that claims 30 and 31are systems and claims 12 and 13 are methods. Since a system carries out a method, prior art applies.

20. Claims 14-15 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katsuya et al in view of Date et al or Kitamura et al, as applied to claims 12 and 30 above, and further in view of U.S. Patent No. 5969798 (Nakagawa et al).

Regarding claim 32, Katsuya et al (as modified by Date et al or Kitamura et al) discloses all of the claimed elements as set forth above and incorporated herein by reference.

Katsuya et al (as modified by Date et al or Kitamura et al) does not disclose expressly each of the first and second print image data represent an image in which at least one print page is laid out on a mount area in accordance with specified page

layout conditions, and the prepress system further comprises: an image region extracting section for extracting an image region corresponding to a same print page from each print image data, based on the page layout conditions specified for each print image data.

Nakagawa et al discloses a plate inspection system that obtains first and second print image data, like Katsuya (fig. 5, s1, s2) which are inspected (fig. 5, s4). The first and second image data represent an image in which at least one print page is laid out on a mount area in accordance with specified page layout conditions (fig. 6, s102), and the prepress system further comprises an image extracting section for extracting an image region corresponding to a same print page from each print image data by reading the full page image data, and thus extracting the regions of the page (fig. 6 and fig. 7) based on the page layout conditions specified for each print image data (fig. 6, s102 precedes the reading in fig. 6 and fig. 7). The extracting section can also be interpreted as that which extracts the position of the alignment marks (fig. 8, s302).

Katsuya et al (as modified by Date et al or Kitamura et al) and Nakagawa et al are combinable because they are from the same field of endeavor, i.e. reading plate images for inspection.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to extract regions of the image for inspection.

The suggestion/motivation for doing so would have been to provide the most accurate and robust inspection by considering all relevant areas of the page.

Therefore, it would have been obvious to combine the system of Katsuya et al (as modified by Date et al or Kitamura et al) with the page layout conditions and extraction of Nakagawa et al to obtain the invention as specified in claim 32.

21. Regarding claim 33, Nakagawa et al discloses the image region extracting section (fig. 8) is configured to rotate the image region of at least one of the first and second print image data so that layout angles of the same print page for the first and second print image data become equal to each other (fig. 8, s306 and 307).

22. Claims 14 and 15 are rejected for the same reasons as claims 32 and 33, respectively. Thus, the arguments analogous to that presented above for claims 32 and 33 are equally applicable to claims 14 and 15. Claims 14 and 15 distinguish from claims 32 and 33 only in that claims 32 and 33 are systems and claims 14 and 15 are methods. Since a system carries out a method, prior art applies.

Conclusion

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KATHLEEN S. YUAN whose telephone number is (571)272-2902. The examiner can normally be reached on Monday to Thursdays, 9 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jingge Wu can be reached on (571)272-7429. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KY
3/18/2009

/Brian P. Werner/
Supervisory Patent Examiner, Art Unit 2624